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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,945	02/22/2002	Brian D. Bailie	TAC 9764.1	4482

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SENNIGER POWERS LEAVITT AND ROEDEL
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16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2121

5

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/081,945

Applicant(s)

BAILIE, BRIAN D.

Examiner

Joseph P. Hirl

Art Unit

2121

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-21 are pending in this application.

2. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

3. Examiner's Opinion:

Para 2 above applies. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Specification

4. The specification is objected to for the following reasons:

In accordance with 37 CFR 1.96(c), computer listings over 300 lines must be submitted as a compact disk and such listings will not be part of the printed patent. The computer program listing of Appendix contains 328 lines of code and should be removed. All references to Appendix contained in the specification should be removed and adjusted accordingly. Applicant should review 37 CFR 1.96 and 1.52(e) to insure application is in full compliance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea or method that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. These claims need to be specifically "computer implemented."

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-14 are rejected under 35 USC 112, first paragraph because current case law (and accordingly, the MPEP) require such a rejection if a 101 rejection is given because when Applicant has not in fact disclosed the practical application for the invention, as a matter of law there is no way Applicant could have disclosed how to practice the undisclosed practical application. This is how the MPEP puts it:

("The how to use prong of section 112 **incorporates as a matter of law** the requirement of 35U.S.C. 101 that the specification disclose as a matter of fact a practical utility for the invention.... If the application fails as a matter of fact to satisfy 35 U.S.C. 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112."); In re Kirk, '376 F.2d 936, 942, 153 USPQ 48, 53 (CCPA 1967) ("Necessarily, compliance with § 112 requires a description of how to use presently useful inventions, **otherwise an applicant would anomalously be required to teach how to use a useless invention.**"). See, MPEP 21107.01 (IV), quoting In re Kirk (emphasis added).

Therefore, claims 1-14 are rejected on this basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-21 rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al (IEEE 1063-6730/94, referred to as **Chen**).

Claims 1, 15

Chen anticipates a knowledge base of a plurality of parameters relating to embroidery designs (**Chen**, p 693, c 2, l 11-18); a rules base of rules interrelating two or more of the parameters(**Chen**, p 693, c 2, l 11-18); selection software for designating a defined parameter from the plurality of parameters (**Chen**, p 695, c 1, l 6-17); analysis software for applying the rules to the defined parameter and for generating one or more recommended parameters as a function of the defined parameter (**Chen**, p 695, c 1, l 6-17); and display software for providing a display corresponding to the defined parameter and the one or more recommended parameters (**Chen**, p 693, c 2, l 3-26; p 695, Fig. 2; Examiner's Note (EN): Chen address computer implementation through the prior art to include the abstract.).

Claims 2, 9, 16

Chen anticipates the parameter is selected from the following categories of parameters: hoping technique, stabilization technique, topping material, backing material, thread weight, thread type, needle type, needle size, embroidery density, project/fabric type, fabric thickness, fabric density, fabric stretch and design size (**Chen**, p 695, c 1, l 6-17).

Claims 3, 10, 17

Chen anticipates the selection software permits the operator to select a parameter and wherein the selection software designates the defined parameter as a function of the operator selected parameter (**Chen**, p 695, c 1, l 6-17).

Claims 4, 11, 18

Chen anticipates the selected parameter is project/fabric type wherein the selection software designates two or more defined parameters and wherein the defined parameters comprise fabric thickness and fabric stretch (**Chen**, p 693, c 1, l 3-26; EN: editing provides the opportunity to adjust parameters such as fabric type which include fabric thickness and stretch characteristics following from the type of rules identified by Chen on page 694, c 2 and further implemented in Fig. 2 on p 695).

Claims 5, 12, 13, 19

Chen anticipates the operator may modify the defined parameter (**Chen**, p 693, c 1, l 18-22; EN: editing will modify the defined parameter).

Claims 6, 20

Chen anticipates the operator may modify the defined parameter and wherein the analysis software applies the rules to the modified defined parameter (**Chen**, p 693, c 1, l 3-26) .

Claims 7, 14, 21

Chen anticipates the knowledge base includes comments, photographs or multimedia presentations which are a function of the selected parameter, the defined

parameter, and/or one or more of the recommended parameters and wherein the display software displays the provided comments, photographs or multimedia presentations (**Chen**, p 694, c 1, l 14-32; p 693, c 1, l 3-26; a graphic representation or photograph is scanned into the knowledge base and the computer-aided design displays the graphic (photo converted) results).

Claim 8

Chen anticipates designating a defined parameter relating to the embroidery design (**Chen**, p 694, c 1, l 40-41); applying the rules to the defined parameter (**Chen**, p 695, c 1, l 6-17); generating one or more recommended parameters as a function of the application of the rules to the defined parameter (**Chen**, p 695, c 1, l 6-17); and displaying the defined parameter and the one or more recommended parameters (**Chen**, p 695, c 1, l 6-17).

Conclusion

11. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

Amin-Nejad, IEE Conference Publication No 465

12. Claims 1-21 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,
Washington, D. C. 20231;

or faxed to:

(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of "Proposed" or "Draft" for the desk of the Examiner).

Hand-delivered responses should be brought to:

Receptionist, Crystal Park II
2121 Crystal Drive,
Arlington, Virginia.

Joseph P. Hirl

April 29, 2004